

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Koch, Kevin

Serial No. 10/710,796

Filed: August 3, 2004

For: COMPUTER PROGRAM PRODUCT
CONTAINING ELECTRONIC
TRANSCRIPT AND EXHIBIT FILES AND
METHOD FOR MAKING SAME

Examiner: Sain, Gautam

Art Unit: 2176

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Reply Brief to the Examiner's Answer dated April 11, 2008, the period for response to which extends until June 11, 2008.

INTRODUCTION

The Examiner's Answer notes that appellant has argued that the appellant's system and methods include the electronic linking of "electronic transcripts" and "electronic exhibit files", which are files containing different information. The Examiner argues that such a feature is not indicated in the claims. The Examiner's argument is inaccurate. The claims clearly identify the two different types of electronic files. It is implicit that these separately identified electronic files contain at least partially different information. To

construe otherwise would lack any basis in logic or fact. Accordingly, this Reply is respectfully submitted to clarify certain points for the Board.

ARGUMENT

In an informal telephone interview between counsel for the appellant and the Examiner, on April 22, 2008, the present issue was discussed. Counsel for the appellant suggested that the appellant would acquiesce to an amendment of the claims to literally note that the electronic transcripts and electronic exhibit files are files containing different information. Counsel further noted, however, that such an amendment is not specifically necessary to overcome the prior art, for the reasons identified herein. In that such an amendment would merely restate the implicit nature of the existing claims, appellant would still agree to implement such amending language.

As clearly defined in the specification:

During a court proceeding such as a deposition, hearing, trial or other proceeding, court reporters transcribe the words spoken into court transcripts. Oftentimes, during court proceedings, various exhibits, such as documents, pictures, maps, charts, or the like, are used or referred to.

(Page 1, lines 10-14.)

Accordingly, a transcript and an exhibit are, by definition, documents containing different information. To be sure, it is conceivable that a portion of a legal transcript could end up as an exhibit in the same legal proceeding being transcribed. However, the transcript and the exhibit representing a portion of the transcript, prior to the exhibit being offered, are clearly different from one another. It is inconceivable where a transcript and an associated exhibit will be the same document, whether electronic or in paper form. In such an instance, the appellant would not claim the documents using different terms, defined as such within the specification. Simply, the limitation would likely read, “electronically linking one copy of an electronic transcript with a second copy of the electronic transcript.” However, such a system would be nearly useless.

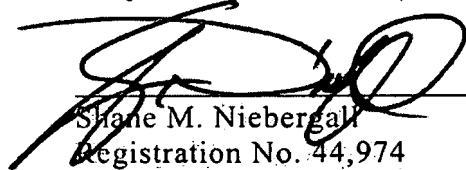
The Examiner is charged with the duty of interpreting the claims in their broadest sense. However, the Examiner is not permitted to interpret the claims so broadly that the interpretation runs counter to the specification's teachings and the accepted understanding of differing terms as they are used in the relevant art.

CONCLUSION AND REQUEST

Based on the above, claims 1-6, 9-14, 17-20 and 34-37 are patentably distinct from the cited reference. Accordingly, reversal of the Examiner's final rejection of claims 1-19 and 21-25, under 35 U.S.C. § 102(b) as being anticipated by the Przecop, et al. reference, is respectfully requested for the above-stated reasons.

Signed this 29th day of April 2008.

Respectfully submitted,



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